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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,655	03/01/2000	Thomas C. Thompson		3209

7590 12/05/2002  
Thomas C Thompson  
92-543 Kokole PLace  
Makakilo, HI 96707

EXAMINER

GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 12/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 09/516,655	Applicant(s) THOMPSON, THOMAS C.	
	Examiner Ernesto Garcia	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Drawings*

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 34A and 35A in Figure 5. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the acute angled bends (claims 1 and 5), the acute angles (claims 3 and 4) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "a retrofit apparatus" is not provided in the specification.

***Claim Objections***

Claim 14 is objected to because of the following informalities:  
regarding claim 14, this claim has a run-on sentence. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, line 9 of claim 1 is providing that the offset web has acute angled bends attached to said base web and said top web. This subject matter was not properly described in the application as filed. Attachment 1 shows applicant's invention describes angles,  $\alpha$ ,  $\beta$ ,  $\lambda$  and  $\pi$  that are not less than 90 degrees nor acute (see attachment 2). Therefore,  $\alpha$ ,  $\beta$ ,  $\lambda$  and  $\pi$  make angle bends that are not less than 90 degrees nor acute.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the limitation "retrofit connector" in line 1 is unclear. Is the connector retrofitted, i.e., furnished with new or modified parts? Furthermore, the limitation "said base web" in line 7 lacks antecedent basis since "a base web" has not been previously recited.

Regarding claim 2, the limitation "as a means" in line 3 is unclear. Is the applicant invoking 112(6), paragraph?

Regarding claims 3 and 4, it is unclear whether the first and the second generally horizontal bends are the acute angled bends or other angled bends. Furthermore, the limitation "having attachment", in lines 1 and 2 in each claim, is unclear.

Regarding claim 5, the limitation "said first and second acute angled bends" lack antecedent basis since "a first acute angled bend and a second acute angled bend" have not been previously recited in claim 5 or claim 1. Furthermore, the limitation "and blocking that stick out" in line 5 is unclear. The limitation "as an offsetting means" is unclear. Is the applicant invoking 112(6) paragraph?

Regarding claim 7, the limitation "said second acute angle bend" in line 3 lacks antecedent basis since "a second acute angle bend" has not been previously recited in claim 7 or claim 1.

Regarding claim 8, the limitation "forming rafter tabs" in line 2 is unclear whether the right angle bends form both the rafter webs as recited in line 6 of claim 1 and the rafter tabs at the same time. It appears that the rafter tabs should be the rafter webs instead.

Regarding claim 9, the limitation "said blocking webs" in line 1 lacks antecedent basis since "blocking webs" have not been previous recited in claim 9, claim 8 or claim 1.

Regarding claim 10, the limitations "said base plate" in line 1, "said rafter tabs" in line 2, "said blocking webs" in line 2, "said exterior wall" in line 4, "said underlying structural member" in line 5, "said roof rafter" in line 5, and "said frieze boards" in line 6 lack antecedent basis since "rafter tabs", "blocking webs", "an exterior wall", "an underlying structural member", "a roof rafter", and "frieze boards" have not been previously recited in claim 10 or claim 1. Furthermore, the limitation "to an existing house" is unclear whether the attaching means is in an existing house. The limitation "as a means" in line 3 is unclear whether applicant is invoking 112(6<sup>th</sup>), paragraph.

Regarding claim 11, the limitation "retrofit apparatus" is unclear. Is the apparatus retrofitted? Furthermore, the limitations "said base web" in line 7 and "said rafter tabs" in line 10 lack antecedent basis since "a base web" and "rafter tabs" have not been previously recited. Furthermore, the limitation "said sheathing tab" in line 17 and "said strengthening tab" in line 17 lack antecedent basis since "a sheathing tab" and "a strengthening tab" have not been previously recited.

Regarding claim 13, the limitation "bolt holes" in line 2 is unclear whether the holes are different of the same as the bolt holes recited in line 21 of claim 11. Furthermore, the limitation ", and having bolt holes" is unclear what feature of the invention has these bolt holes. Furthermore, the limitation "said holes" in line 5 is

unclear whether these holes are the holes recited in lines 2 or 4 of claim 13, or line 21 of claim 11.

Regarding claim 14, the limitation "said apparatus below said roof" is unclear since claim 14 or claim 11 has not positively recited that the apparatus is below a roof.

Regarding claim 6, the claim depends from claim 5 and therefore is indefinite.

Regarding claims 12 and 14, the claims depend from claim 11 and therefore are indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).



Claims 1 and 3-7, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Thompson, 6,094,880 (see marked-up attachment).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Thompson discloses in Figure 10 a unitary connector comprising a base web **34A**, and an offset, angled, top web **34**. The top web **34** has generally right angle bends **A3** forming rafter webs. The base web **34A** and the top web **34** are connected by an offset web **20A**. The offset web **20A** has angled bends **A5** attached to the base web **34A** and the top web **34**.

Regarding claim 2, the base web **34A** has a generally flat, generally long-horizontal rectangular shape, and nail holes **A6**. Applicant is reminded that the holes **A6** are for retrofitting to the exterior wall, and into an underlying structural member.

Regarding claims 3, the offset web **20A** is attached to the base web **34A**.

Regarding claim 4, the offset web **20A** is attached to the top web **34**.

Regarding claims 5-7, these claims are impossible to examine due to ambiguities in the claim. Applicant is reminded that a recitation with respect to the manner in which an apparatus is intended to be employed does not impose any structural limitation upon the claimed apparatus, which differentiates it from a prior art reference disclosing the structural limitations of the claim. In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); In re Yanush, 477 F.2d 958, 177 USPQ 705 (CCPA 1973); In re Finsterwalder, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971); In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 136 USPQ 458 (CCPA 1963); Ex parte Masham, 2 USPQ2d 1647 (BdPatApp & Inter 1987).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1 and 3-7 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

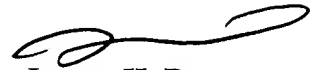
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this

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application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.



**Lynne H. Browne**  
**Supervisory Patent Examiner**  
**Technology Center 3600**

E.G.

December 2, 2002

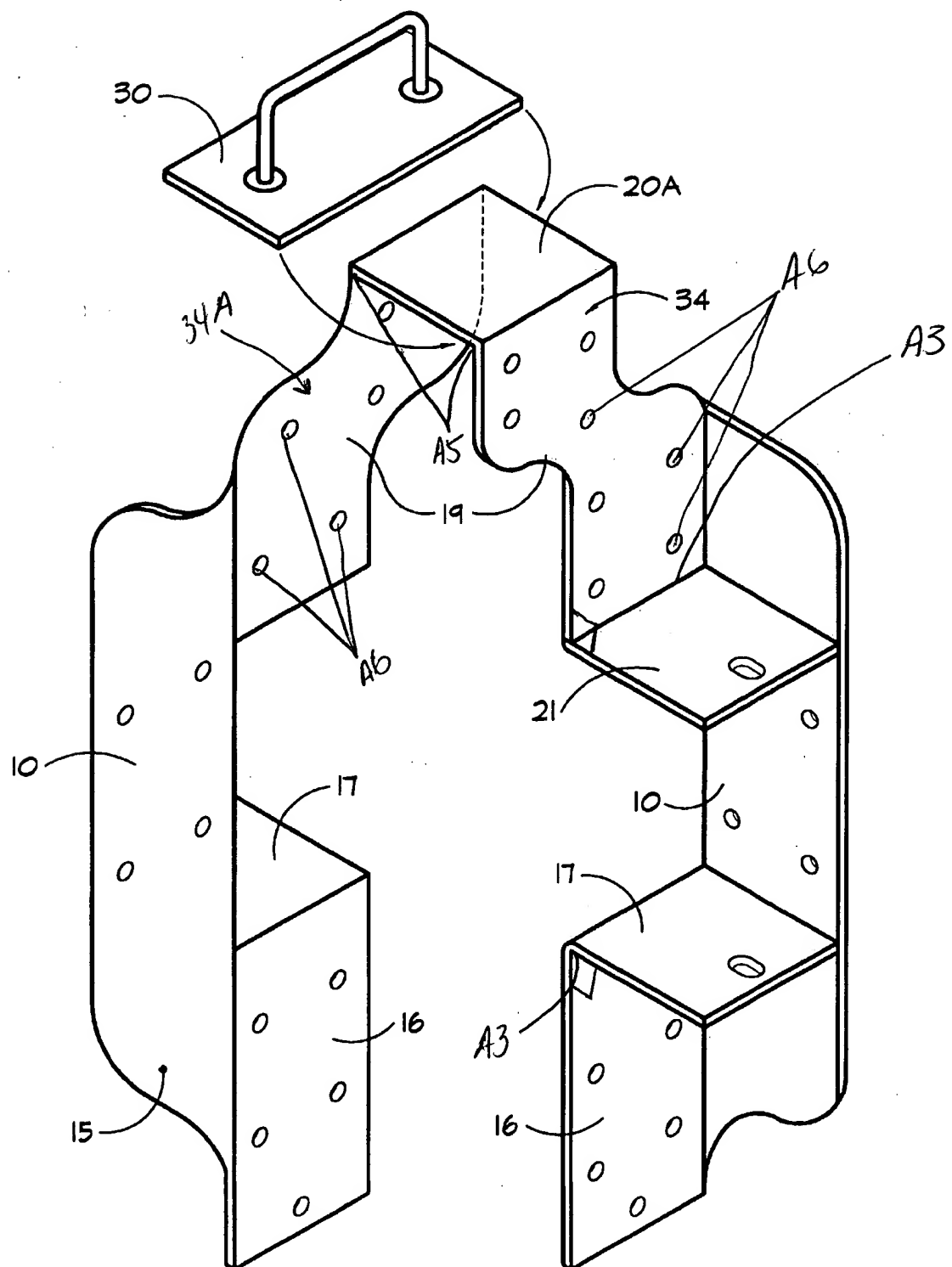
Attachments: one marked-up copy of applicant's invention;  
one copy of Webster's definition of acute; and,  
one copy of Thompson, 6,094,880.

T



FIG. 2





**FIG. 10**